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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/646,009	10/05/2012	Bryan T. Johnson	347.00210120	6978

26813 7590 02/01/2017  
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EXAMINER
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WRIGHT, KIMBERLEY S

ART UNIT	PAPER NUMBER
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3637

MAIL DATE	DELIVERY MODE
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02/01/2017

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* BRYAN T. JOHNSON

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Appeal 2015-002306  
Application 13/646,009  
Technology Center 3600

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Before: CHARLES N. GREENHUT, ANNETTE R. REIMERS, and  
PAUL J. KORNICZKY, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1–4, 6, 7, 10–23.<sup>1</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We affirm and designate a new ground of rejection.

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<sup>1</sup> Claims 5, 8, and 9 have been cancelled.

### CLAIMED SUBJECT MATTER

The claims are directed to a material holder. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1 A material holder for use with a structure, the material holder comprising:

a frame;

material holding apparatus coupled to the frame and configured to hold a roll of material contained within a box vertically, wherein the material holding apparatus comprises:

a lower box support portion coupled to the frame, wherein the lower box support portion is configured to support a bottom end of the box and to restrict the bottom end of the box from horizontal movement, an upper box support portion coupled to the frame, wherein the upper box support portion is configured to support a top end of the box and to restrict the top end of the box from horizontal movement, and a lower support disc rotationally coupled proximate to the lower box support portion and configured to support the roll of material vertically thereon for rotational movement thereof;

material retention apparatus configured to selectively retain the roll of material and box using the material holding apparatus, wherein the material retention apparatus is selectively configurable in at least an open configuration and a closed configuration, wherein the roll of material and box are removable from the material holding apparatus when the material retention apparatus is in the open configuration, and wherein the roll of material and box are retained by the material holding apparatus when the material retention apparatus is in the closed configuration; and

frame retention apparatus coupled to the frame and configured to couple the frame to the structure above a ground surface.

## REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Podoloff	US 3,245,165	Apr. 12, 1966
Waltz	US 3,570,731	Mar. 16, 1971
Nathan	US 5,568,864	Oct. 29, 1996

## REJECTIONS

Claims 1–4, 6, 7, 10, 11, 13–15, 19, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Waltz, Nathan, and Podoloff.

Claims 12, 16–18 and 21–23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Waltz and Nathan

## OPINION

Regarding the respective rejections of independent claims 1 and 12, Appellant primarily takes issue with the Examiner’s proposed combination of Waltz and Nathan. *See* App. Br. 8–13, 17–22. Appellant contends the Examiner’s proposed modification “would render the invention of Waltz unsatisfactory for its intended purpose” (App. Br. 8–11) and “would change the principle of operation of Waltz” (App. Br. 12–13). We recognize that the Examiner conflates these arguments in the Answer. Ans. 3; Reply Br. 2–3. Nevertheless, these arguments do not apprise us of error in the Examiner’s rejections. The Examiner’s rejections and response addresses the factual and technical substance of both arguments.

Appellant’s first argument forms the basis for *both* of Appellant’s assertions that the Examiner’s proposed modification would change the principle of operation of, and render the invention of Waltz unsatisfactory

for its intended purpose. App. Br. 8–9, 11–13. This argument is premised on the notion that combining the teachings of Waltz and Nathan would require the use of Nathan’s elongated spool or rod 10. *Id.* First, as the Examiner points out (Ans. 3), “[i]t is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.” *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012). Second, and more importantly, the Examiner never proposes to incorporate Nathan’s entire spool or rod. The Examiner specifically indicates that the proposed combination would retain Waltz’s discrete upper and lower spindles 56, 23. Final Act. 3 (“...each spindle extends into a dispensing box...”)(emphasis added). Appellant does not apprise us of any technical reason a rod traversing the entire length of the roll would be necessary to employ Nathan’s brackets 22, 27 in Waltz’s device. Instead, securing components performing the functions of Nathan’s wing nut 14, cotter pin 19, and washer 20, could be provided at each end of the roll, for example. Waltz already depicts securing arrangements, divergence 62 and screw head 44, that function similar to Nathan’s cotter pin 19 and washer 20, and are suitable for securing separate spindles at each end of the roll. In arguing against the use of Nathan’s rod 10, Appellant is essentially creating a new rejection, different from that set forth by the Examiner, in order to argue against it. We are not apprised of error in the Examiner’s rejection based on this argument. *See* 37 C.F.R. § 41.37(c)(iv) (“The arguments shall explain why the examiner erred as to each ground of rejection”).

Appellant’s next argument is premised on the Examiner’s proposed combination to incorporate a box rendering the Waltz cutting bars 68

unsatisfactory. App. Br. 10–11. Initially, we note that we do not have the same trouble seeing how Waltz’s cutters could coexist with a box (App. Br. 11) as the cutting function would not be impeded so long as the cutter is arranged such that it could engage the sheet material when the material exits the box. Nevertheless, the Examiner correctly points out that alternative cutting arrangements such as Nathan’s serrations built into the box<sup>2</sup> could be used when boxed sheeting is employed. *See* Ans. 4.

For the reasons discussed above, we affirm the rejection of claim 1 and turn to the remaining issues specifically related to claim 12.

The preamble of claim 12 recites, “A material holder for use with a structure.” The only further reference to the “structure” in claim 12 is set forth when reciting the “frame” component of the claimed material holder: “a frame capable of being removably coupled to the structure.” From these two limitations it is clear that the “structure” itself does not form part of the claimed combination. Instead, the “structure” is used to define, first, the intended use of the “material holder,” and, second, the capabilities of the “frame.” In regards to the “frame,” the “frame” must be “capable of being removably coupled to the structure.” The absence of any specific details regarding the structure or the coupling arrangement or technique renders this limitation quite broad.<sup>3</sup> “By its own literal terms a claim employing such [functional] language covers any and all embodiments which perform the

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<sup>2</sup> Although visible in Figure 2, Nathan does not provide a reference numeral for, or discuss, the box’s serrated cutting edge—a common component of aluminum foil or plastic wrap boxes. *See* col. 2, ll. 42–45.

<sup>3</sup> “‘Functional’ terminology may render a claim quite broad. By its own literal terms a claim employing such language covers any and all embodiments which perform the recited function.” *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971).

recited function.” *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971).

Turning to Waltz, the simple fact that Waltz’s frame 11 is capable of being chained to a post, in the same manner as a bicycle, for example, makes Waltz’s frame reasonably regarded as being “capable of being removably coupled to [a] structure [used with the material holder].” A post is a structure with which Waltz’s material holder can be used and to which Waltz’s frame can be removably coupled by virtue of lock and chain for example. Thus, this disputed limitation does not ultimately distinguish the recited “frame” from frame 11 of Waltz. However, of the many “structure[s]” to which Waltz’s frame is “capable of being removably coupled,” the structures identified by the Examiner, cross bars 12, 13 (Final Act. 6) are not reasonably regarded as among them. As Appellant correctly points out, there is insufficient detail to determine the relationship between the cross bars 12, 13 and the frame 11. If they are fixed by welding or the like, for example, they would not be reasonably regarded by the skilled artisan as a structure to which the frame is “capable of being removably coupled.” Thus, Appellant correctly identifies an error with regard to the Examiner’s rejection of claim 12. *See App. Br. 16*. However, that error does not ultimately mean that claim 12 was improperly rejected on the combination of Waltz and Nathan for the reasons discussed above.

Accordingly, while we affirm the rejection of claim 12 and its dependents, we designate that affirmance as including a new ground of rejection to ensure Appellant has a fair opportunity to respond.

The last substantive issue raised relates to claims 20 and 23. *App. Br. 13, 22*. Although not fully developed in the record, we understand the disagreement between Appellant and the Examiner regarding these claims to

stem from an issue of claim construction. The claims each recite “wherein the lower box support portion restricts all four sides of the lower end of the box from horizontal movement.” The Examiner correctly determined this limitation would be satisfied by virtue of using Nathan’s box holding brackets. Ans. 4. This is true because even though Nathan’s brackets may only *contact* or *engage* two sides of the box, all four sides are *restricted* from horizontal movement by virtue of restricting movement of the entire box as a cohesive unit. Appellant’s preferred embodiment may depict a box support portion 322 configured to *contact* or *engage* all four sides of the lower end of a box (*see, e.g.*, Fig. 23). However, neither claim 20 nor claim 23 sets forth any such requirement. Appellant’s argument is not commensurate in scope with the claims. Limitations not appearing in the claims cannot be relied upon for patentability *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

## DECISION

The Examiner’s rejection of claims 1–4, 6, 7, 10, 11, 19, and 20 is affirmed.

The Examiner’s rejections of claims 12–18 and 21–23 are affirmed but that affirmance is designated as including a new ground of rejection under 37 C.F.R. § 41.50(b).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:



When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Patent Trial and Appeal Board for final action on the affirmed rejection, including any timely request for rehearing thereof.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)